

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# Patent Public Advisory Committee Quarterly Meeting

## Patent Trial and Appeal Board Update

Nathan K. Kelley

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August 20, 2015

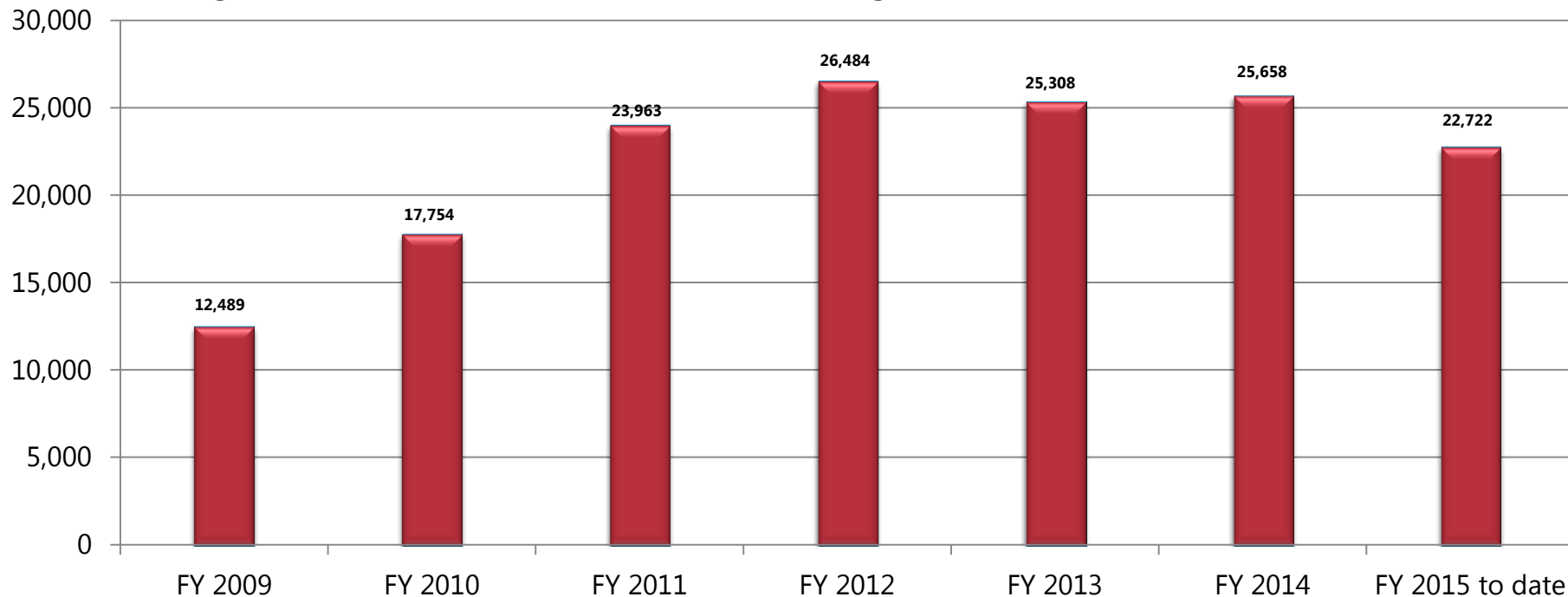
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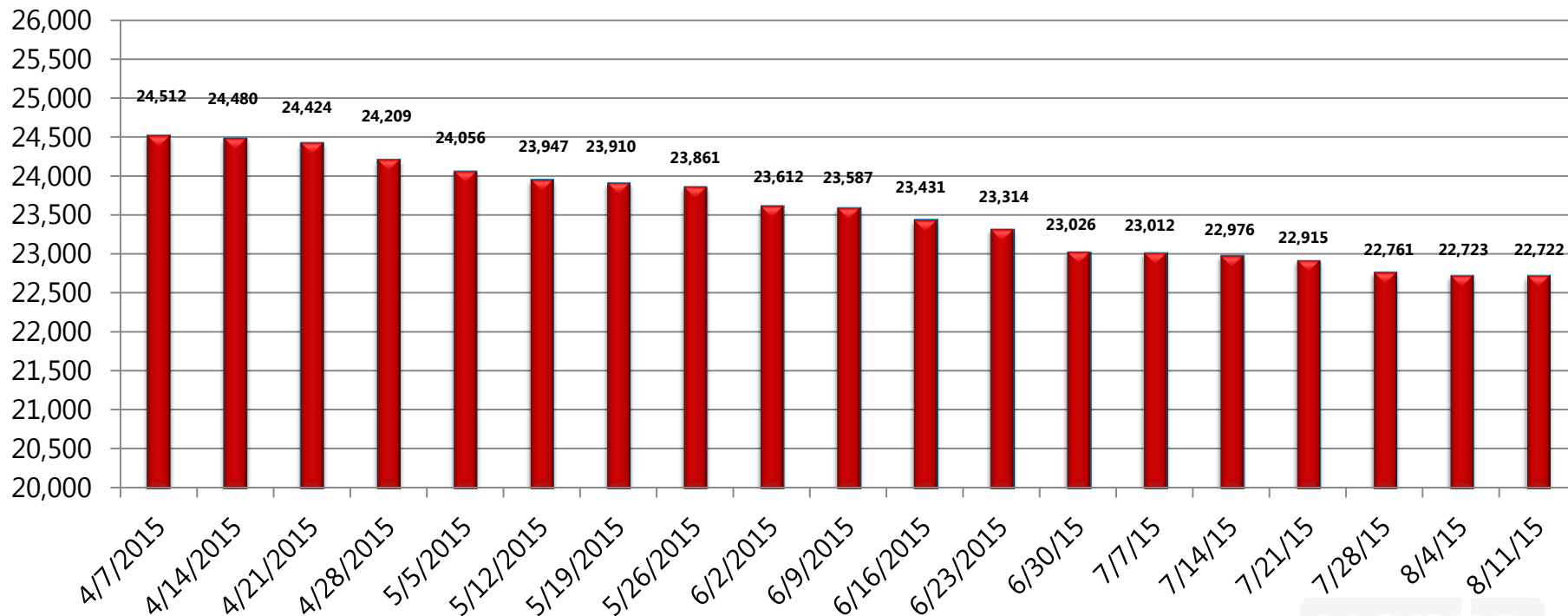
# Appeals Statistics

# PTAB Inventory – Pending Ex Parte Appeals

(excluding appeals from reexamination proceedings)



# PTAB Inventory – Pending Ex Parte Appeals (excluding appeals from reexamination proceedings)



# PTAB Receipts and Dispositions

*Period: 07/11/2015 thru 08/11/2015*

Discipline	# Cases Received	# Cases Disposed	Difference (Disposed minus Received)
Biotech	64	37	-27
Business Methods	35	104	69
Chemical	116	125	9
Contested Cases	65	24	-41
Design	2	1	-1
Electrical	329	507	178
Mechanical	208	240	32
***Totals***	819	1038	219

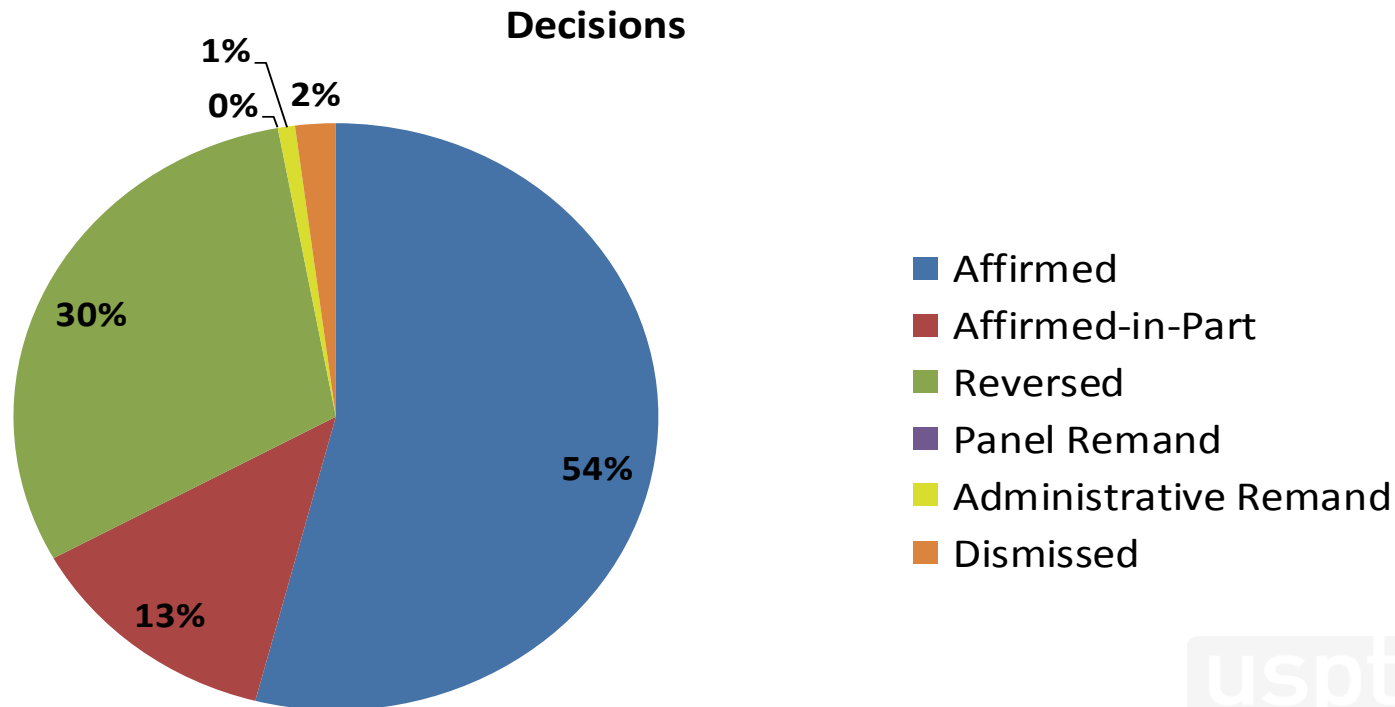
uspto

# Pendency of Decided Appeals

(from 10/1/2014 through 7/31/2015)

Discipline	Technology Center	Number of Decisions	Pendency from PTAB Docketing to Decision (Months)
Biotech	1600	395	32.4
Chemical	1700	1152	24.9
Electrical	2100	1490	31.7
	2400	1698	31.4
	2600	1305	31.3
	2800	626	27.0
Designs	2900	20	26.2
Mech/Bus Methods	3600	1671	31.6
	3700	1389	30.1
Reexams	3900	218	6.0
Total Average		9,964	29.7

# Decisions by Type: FY2014





# **Expedited Patent Appeal Pilot**

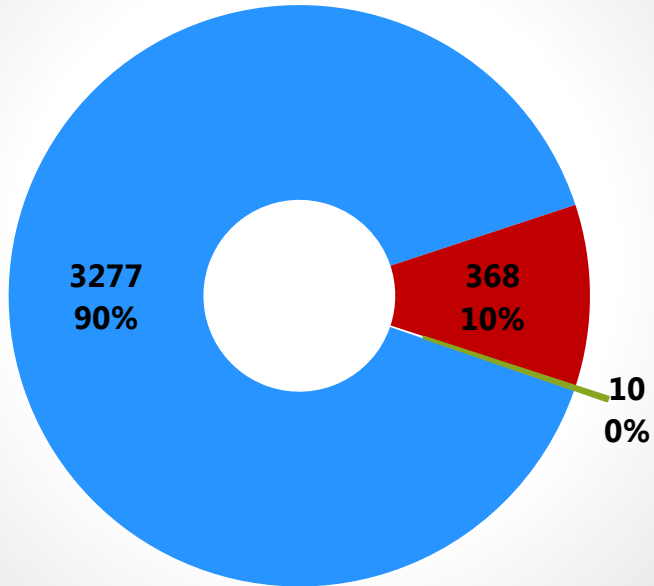
# Expedited Patent Appeal Pilot (EPAP)

- *Ex parte* appeal accorded special status when another is withdrawn
- Pilot effective June 19, 2015 for up to a year
- Timing Goal - 2 months to grant petition & 4 months from the date of petition grant to decide appeal
- Data through August 11, 2015: 19 petitions filed (18 granted and 1 denied); Average time to decide petition < 2 days.

# **AIA Statistics**

## 3655 Total AIA Petitions\*

Cumulative from 09/16/2012

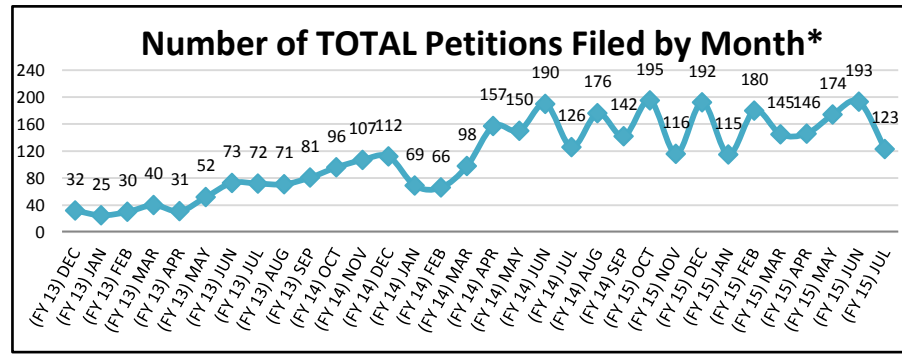
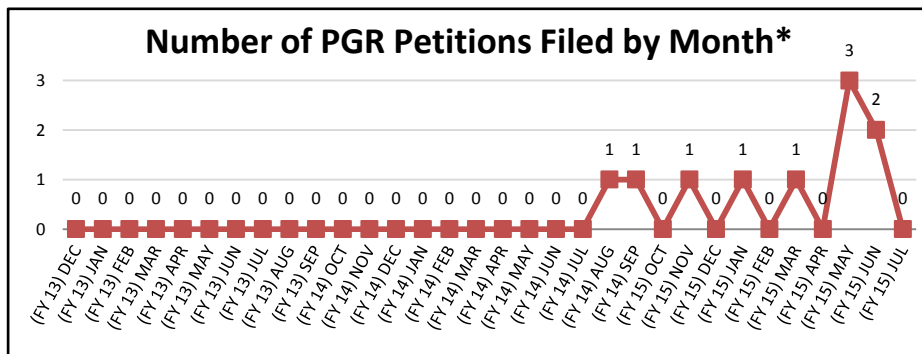
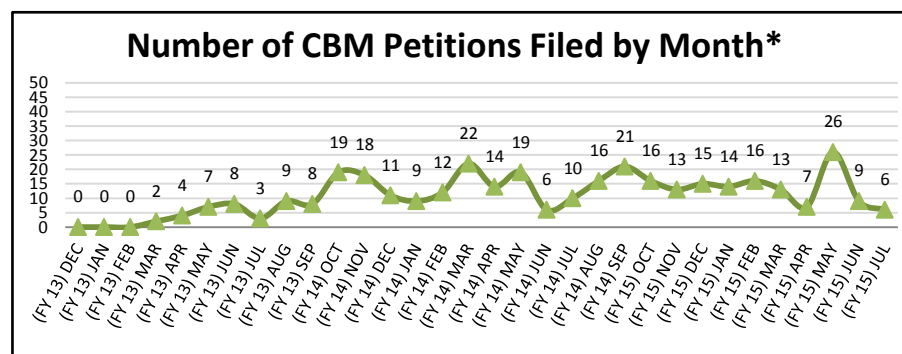
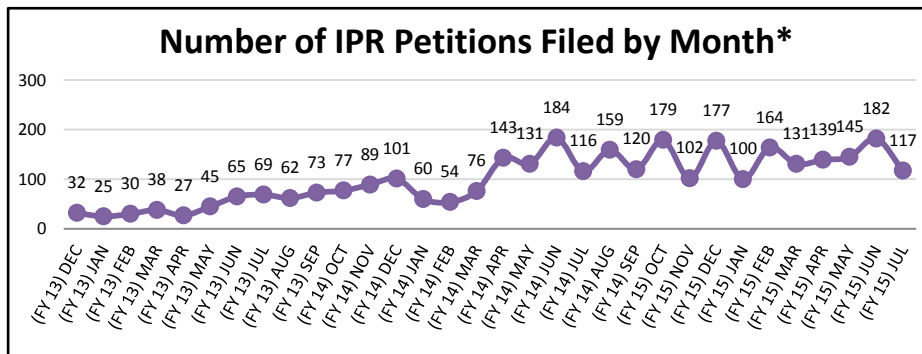


■ Total IPR Petitions ■ Total CBM Petitions ■ Total PGR Petitions

### Narrative:

This pie chart shows the total number of cumulative AIA petitions filed to date broken out by trial type (i.e., IPR, CBM, and PGR).

**\*Data current as of: 7/31/2015**



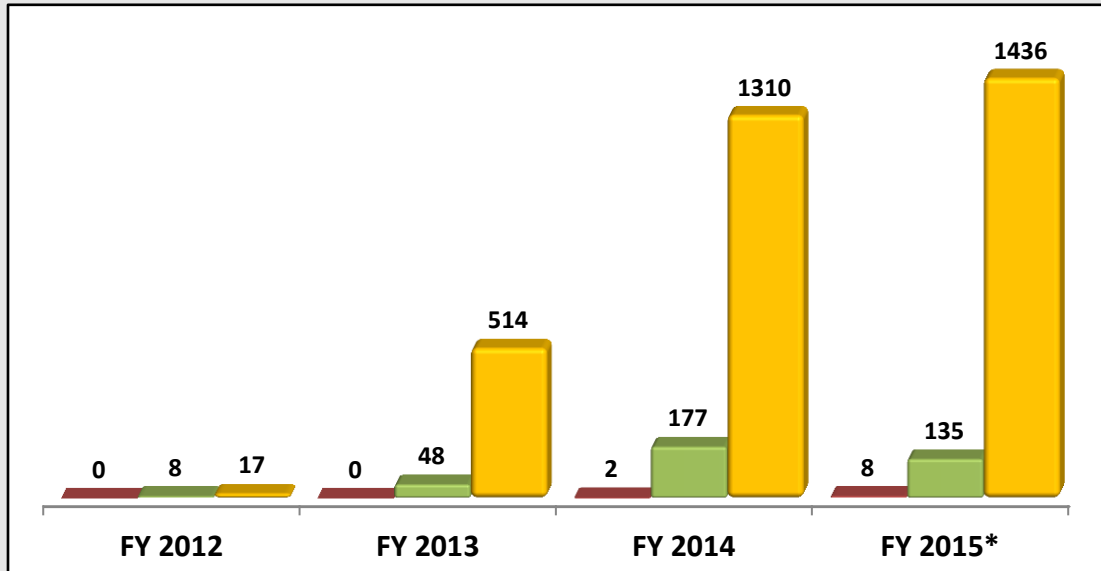
**Narrative:**

These line graphs display the number of IPR, CBM, and PGR petitions filed each month and the total number of all petitions filed each month from the effective date of the AIA trial provisions.

**\*Data current as of: 7/31/2015**

### Number of AIA Petitions Filed by Fiscal Year by Type

■ PGR   ■ CBM   ■ IPR

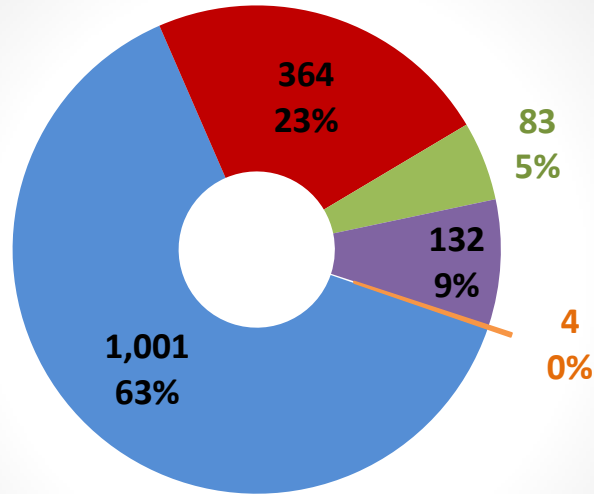


#### **Narrative:**

This bar graph depicts the number of AIA petitions filed each fiscal year, with each bar showing the filings for that fiscal year by trial type (i.e., IPR, CBM, and PGR).

**\*Data current as of: 7/31/2015**

**1584 Total AIA Petitions in FY 2015\***  
**(Technology Breakdown)**



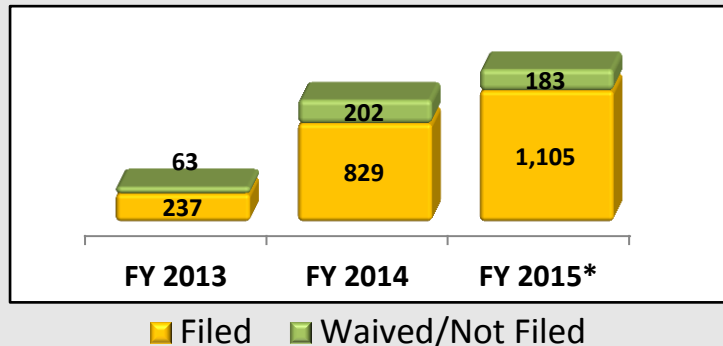
- Electrical/Computer - TCs 2100, 2400, 2600, 2800
- Mechanical/Business Method - TCs 3600, 3700
- Chemical - TC 1700
- Bio/Pharma - TC 1600
- Design - TC 2900

**Narrative:**

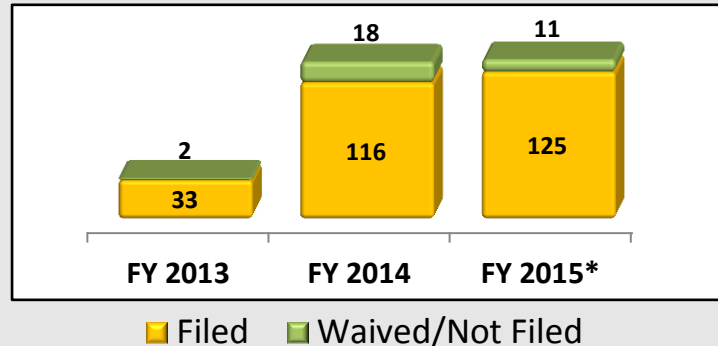
This pie chart shows the total number of AIA petitions filed in the current fiscal year to date as well as the number and percentage of these petitions broken down by technology.

**\*Data current as of: 7/31/2015**

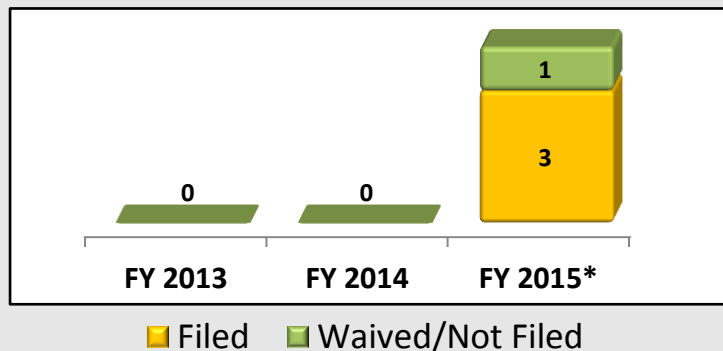
**IPR - Number of Patent Owner Preliminary Responses by Fiscal Year**



**CBM - Number of Patent Owner Preliminary Responses by Fiscal Year**



**PGR - Number of Patent Owner Preliminary Responses by Fiscal Year**



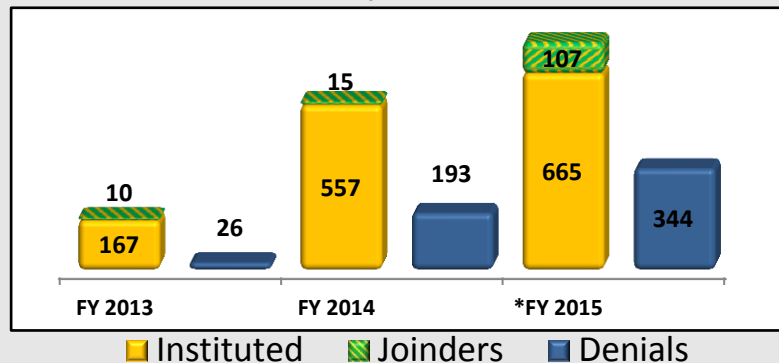
### **Narrative:**

These three sets of bar graphs show the number of patent owner preliminary responses filed and waived/not filed each fiscal year in IPR, CBM, and PGR proceedings.

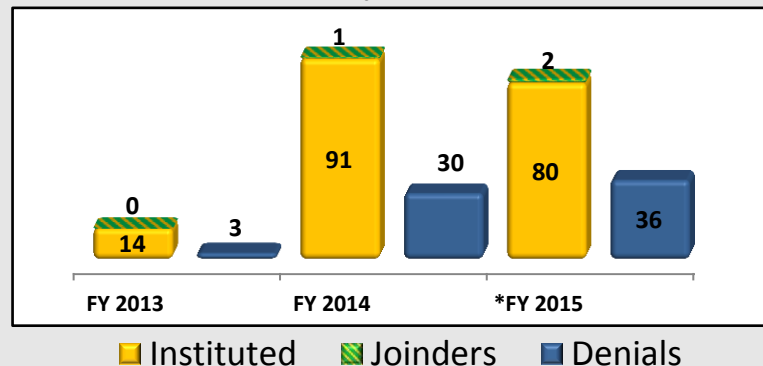
**\*Data current as of: 7/31/2015**



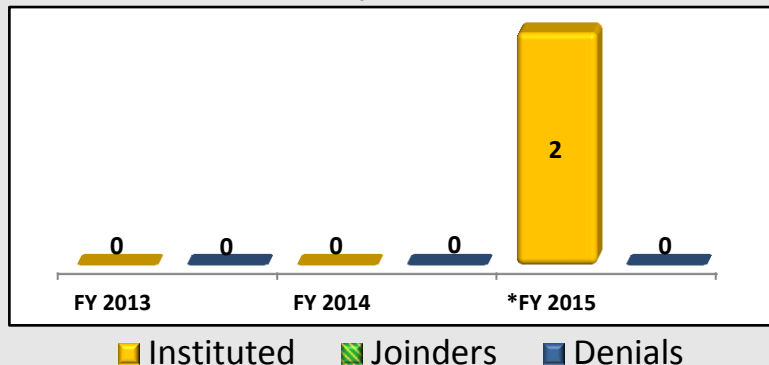
**IPR - Number of Decisions On Institution Per Fiscal Year by Outcome**



**CBM - Number of Decisions On Institution Per Fiscal Year by Outcome**



**PGR - Number of Decisions On Institution Per Fiscal Year by Outcome**

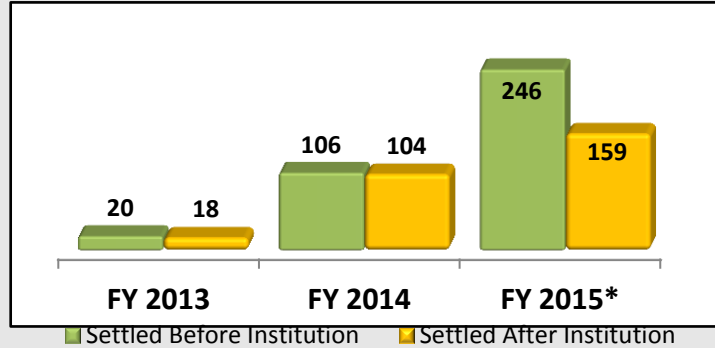


### Narrative:

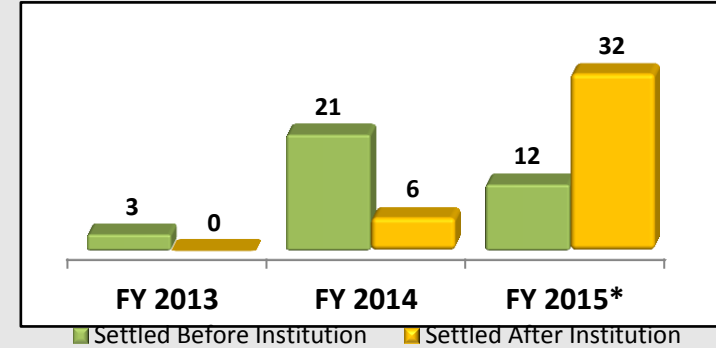
These three sets of bar graphs show the number of decisions on institution by fiscal year broken out by trials instituted (including joinders) and trials denied in IPR, CBM, and PGR proceedings. A trial that is instituted in part is counted as an institution in these bar graphs.

**\*Data current as of: 7/31/2015**

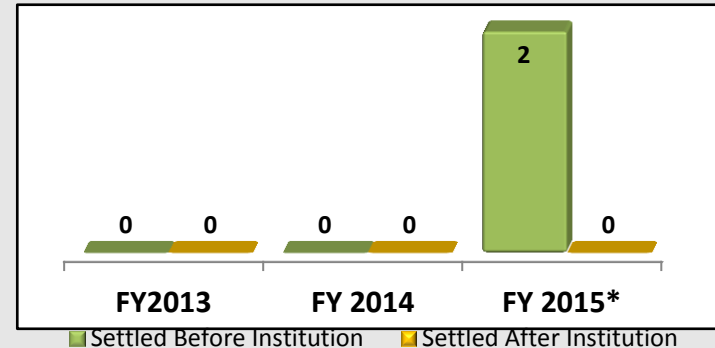
### IPR - Settlements



### CBM - Settlements



### PGR - Settlements

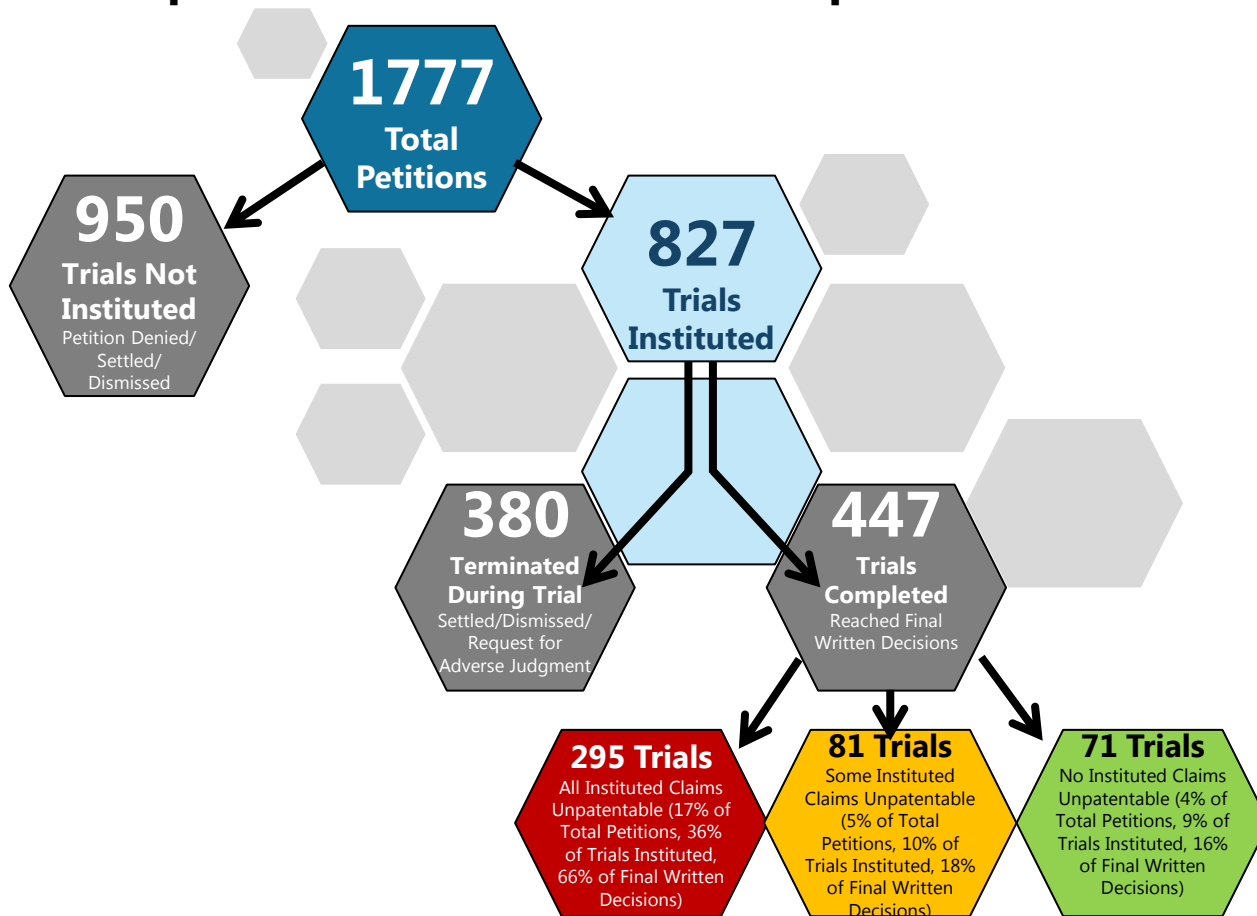


#### Narrative:

These three sets of bar graphs show settlements in AIA trials broken down by settlements that occurred prior to institution and settlements that occurred after institution in IPR, CBM, and PGR proceedings.

**\*Data current as of: 7/31/2015**

## Disposition of IPR Petitions Completed to Date\*

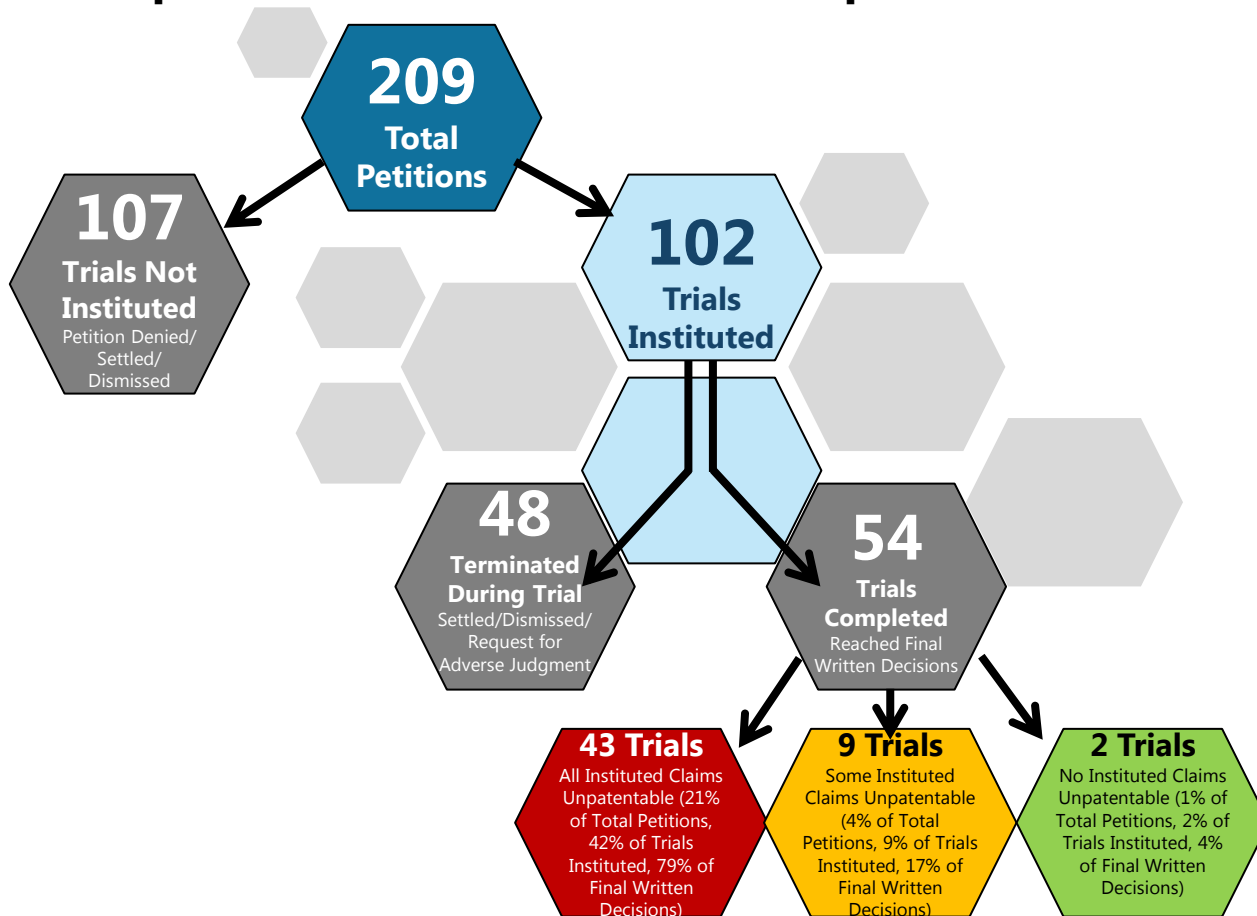


### Narrative:

This graph shows a stepping stone visual depicting the outcomes for all IPR petitions filed to-date that have reached a final disposition.

\*Data current as of: 7/31/2015

## Disposition of CBM Petitions Completed to Date\*

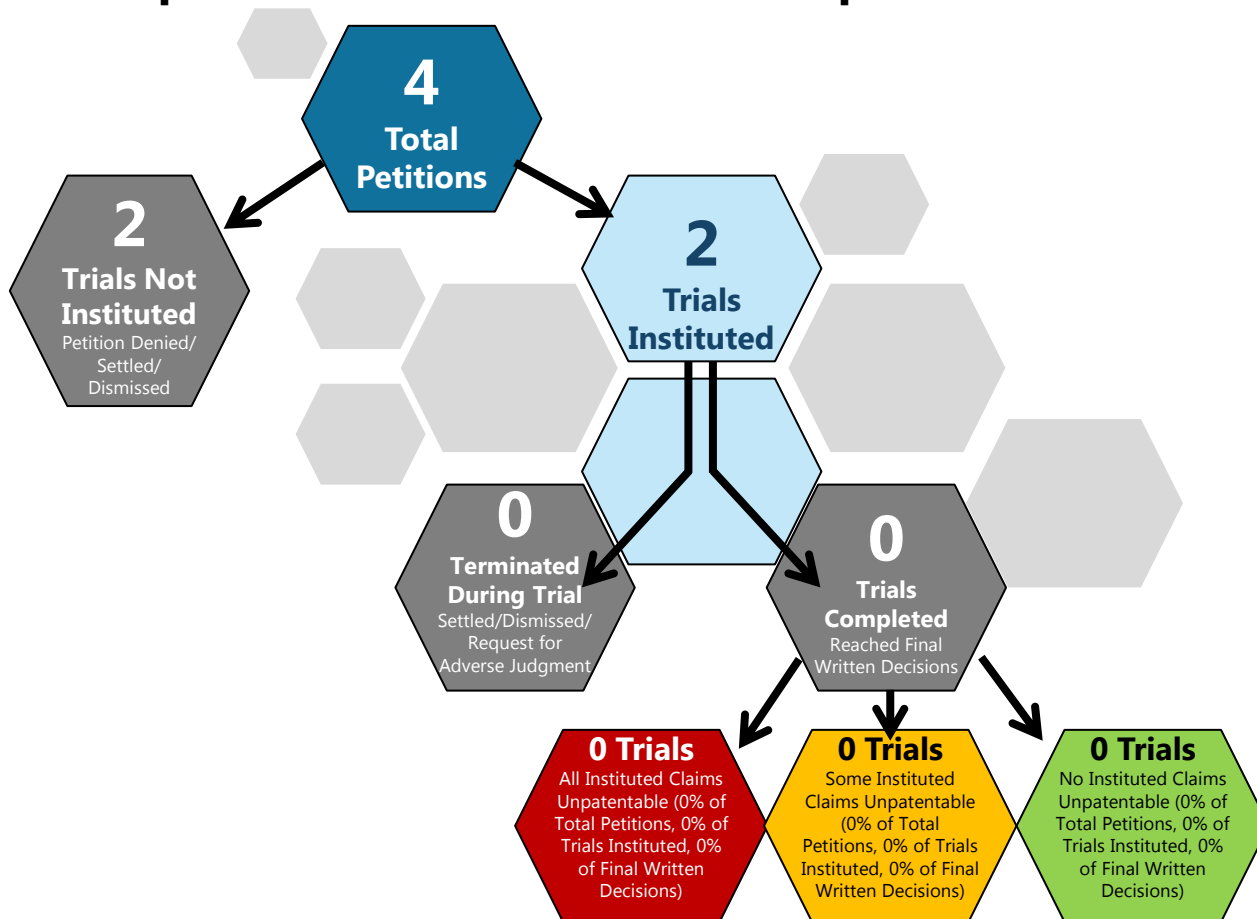


### Narrative:

This graph shows a stepping stone visual depicting the outcomes for all CBM petitions filed to-date that have reached a final disposition.

\*Data current as of: 7/31/2015

## Disposition of PGR Petitions Completed to Date\*

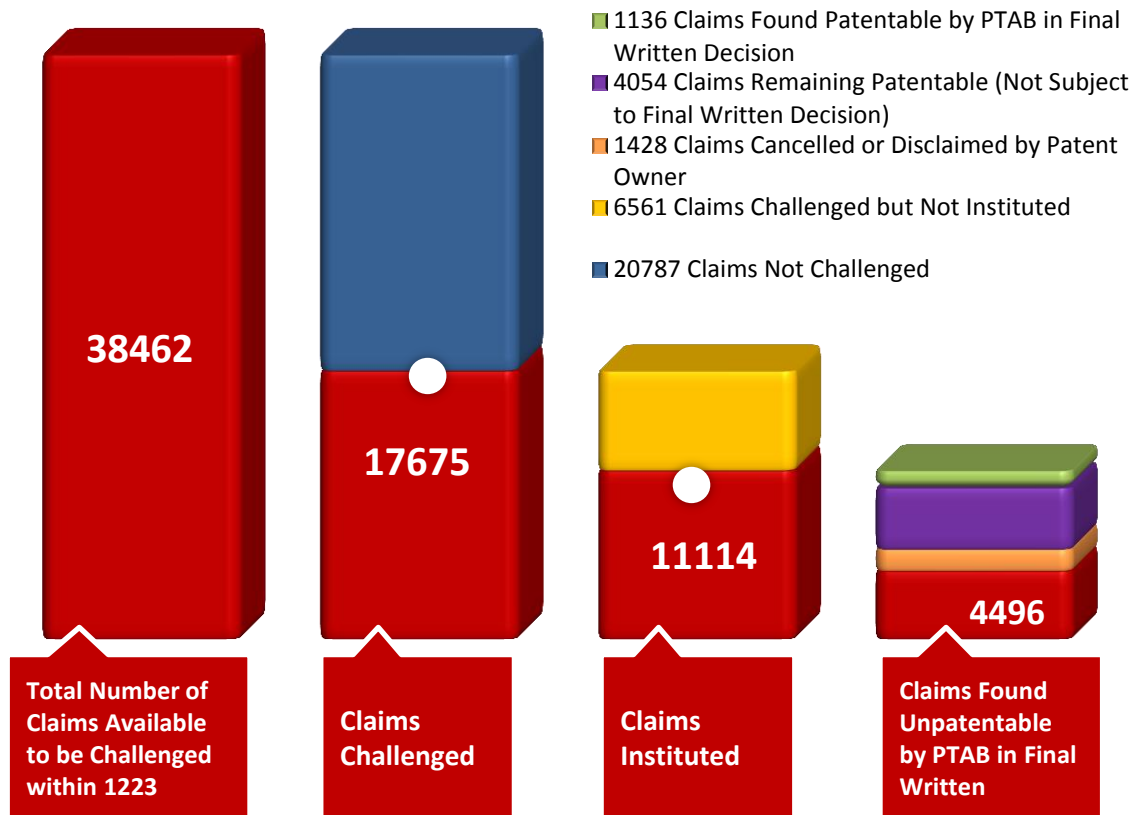


### Narrative:

This graph shows a stepping stone visual depicting the outcomes for all PGR petitions filed to-date that have reached a final disposition.

\*Data current as of: 7/31/2015

## IPR Petitions Terminated to Date\*



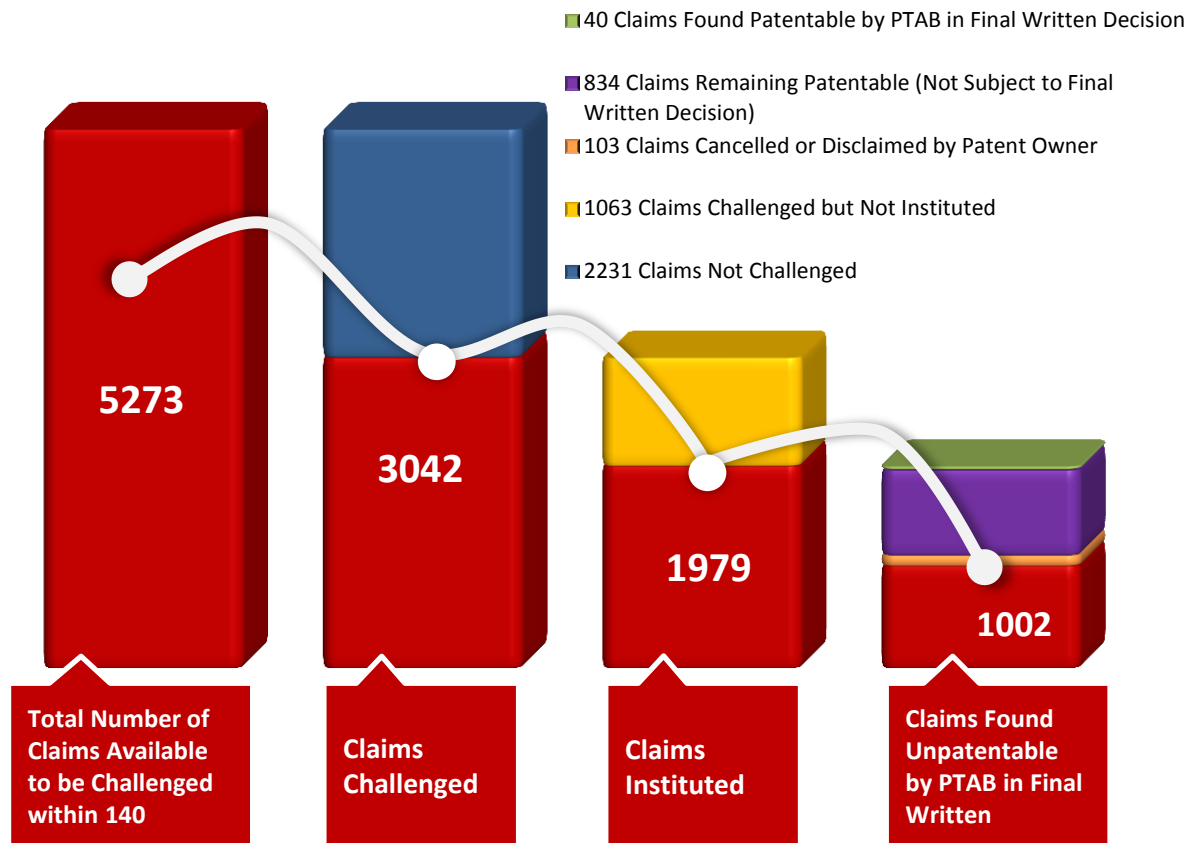
### **Narrative:**

This visual contains four bars. The first bar shows the total number of claims available to be challenged in the IPR petitions filed. The second bar shows the number of claims actually challenged and not challenged. The third bar shows the number of claims on which trial was instituted and not instituted. The fourth bar shows the total number claims found unpatentable in a final written decision, the number of claims canceled or disclaimed by patent owner, the number of claims remaining patentable (not subject to a final written decision), and the number of claims found patentable by the PTAB.

**Note:** Petitions terminated does not include petitions denied

**\*Data current as of: 7/31/2015**

## CBM Petitions Terminated to Date\*



### **Narrative:**

This visual contains four bars. The first bar shows the total number of claims available to be challenged in the CBM petitions filed. The second bar shows the number of claims actually challenged and not challenged. The third bar shows the number of claims on which trial was instituted and not instituted. The fourth bar shows the total number claims found unpatentable in a final written decision, the number of claims canceled or disclaimed by patent owner, the number of claims remaining patentable (not subject to a final written decision), and the number of claims found patentable by the PTAB.

**Note:** Petitions terminated does not included petitions denied.

**\*Data current as of: 7/31/2015**

# Motions-to-Amend



# Motions-to-Amend

- *MasterImage 3D, Inc. v. RealD Inc.*, Case IPR2015-00040 (PTAB July 15, 2015) (Paper 42) (representative).
  - Clarified earlier *Idle Free* decision
  - Patent Owner must show patentable distinction over prior art of record (in the proceeding; in the prosecution history; in any other proceeding involving the same patent)
  - Duty of candor and good faith in the Office may lead to additional prior art made of record by the Patent Owner when moving to amend

# **AIA Trial Rulemaking Update**

# AIA Trial Rulemaking

- In response to stakeholder requests, the Office moved forward with two rule packages:
  1. A first final rule package that encompassed less difficult “quick-fixes” based upon both stakeholder comments and internal PTAB suggestions, including more pages for briefing for motions to amend and for petitioner’s reply brief; and
  2. A second proposed rule package that published today.
- The second proposed rule package addresses the remaining issues raised in comments received from the public, as well as providing more guidance concerning our growing experience with AIA proceedings.
- The public has sixty days to provide the Office with comments on the proposed rules. The Office will issue a final rule, responding to these comments, and also issue a revised Office Patent Trial Practice Guide reflecting guidance concerning our current practice in handling AIA proceedings.

# AIA Trial Rulemaking

In the second proposed rule package, the Office proposes making the following changes to the rules.

- Proposes to allow patent owners to include, with their opposition to a petition to institute a proceeding, new testimonial evidence such as expert declaration, responding to commentary raising concerns that patent owners are disadvantaged by current rules letting petitioners' evidence go unanswered before a trial is instituted
- Proposes a new requirement on practitioners before the PTAB, akin to the Rule 11 requirements in federal courts, that would give the USPTO a more robust means with which to police misconduct
- Proposes to clarify that the PTAB will use the claim construction standard used by district courts for patents that will expire during proceedings and therefore cannot be amended, while confirming the use of broadest reasonable interpretation (BRI) for all other cases
- Notes the PTAB's development of motions-to-amend practice through its own body of decisions, including a recent decision that clarified what prior art a patent owner must address to meet its burden of proof
- Proposes using a word count for major briefing so that parties are free to present arguments and evidence to the Office in a way that a party deems is most effective, including presenting arguments in claim charts

# **USPTO & AIPLA Roadshows**

# Upcoming Roadshows

## August 2015

The USPTO will co-host, with AIPLA, a series of cross-country roadshows in August. The full-day program will focus on enhancing patent quality (morning session) and conducting AIA trials (afternoon session) with numerous speakers from the USPTO as well as private practice.

CLE is available, and lunch is included. To register to attend, please visit:  
<http://www.aipla.org/learningcenter/AIARoadShows/Pages/default.aspx>

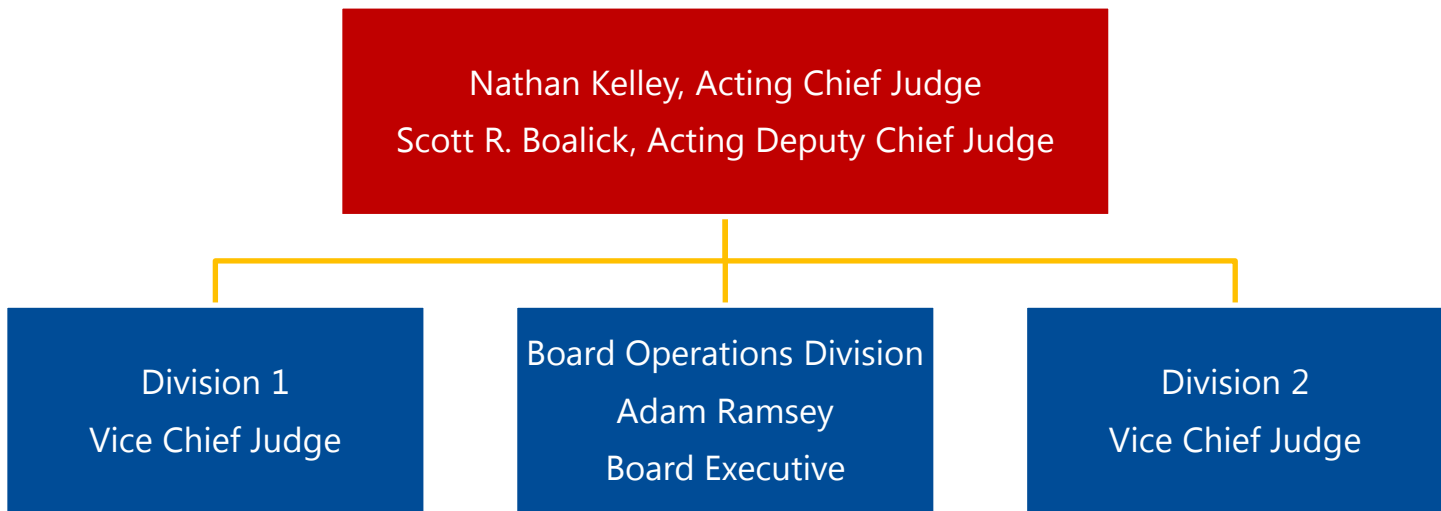
### Schedule

- Monday, August 24, 2015
  - Santa Clara University, Locatelli Center
  - Co-sponsored by the High Tech Institute of Santa Clara
- Wednesday, August 26, 2015
  - Belo Mansion, Dallas
  - Co-sponsored by the IP Section of the Dallas Bar Association
- Friday, August 28, 2015
  - USPTO headquarters, Madison Auditorium



# **PTAB Management**

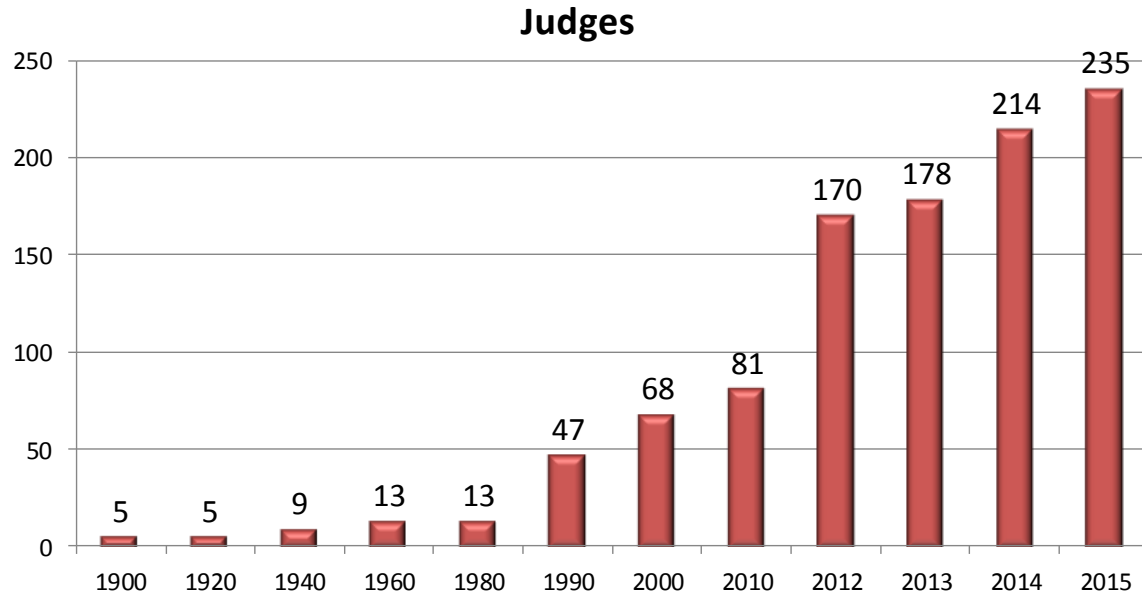
# PTAB Management



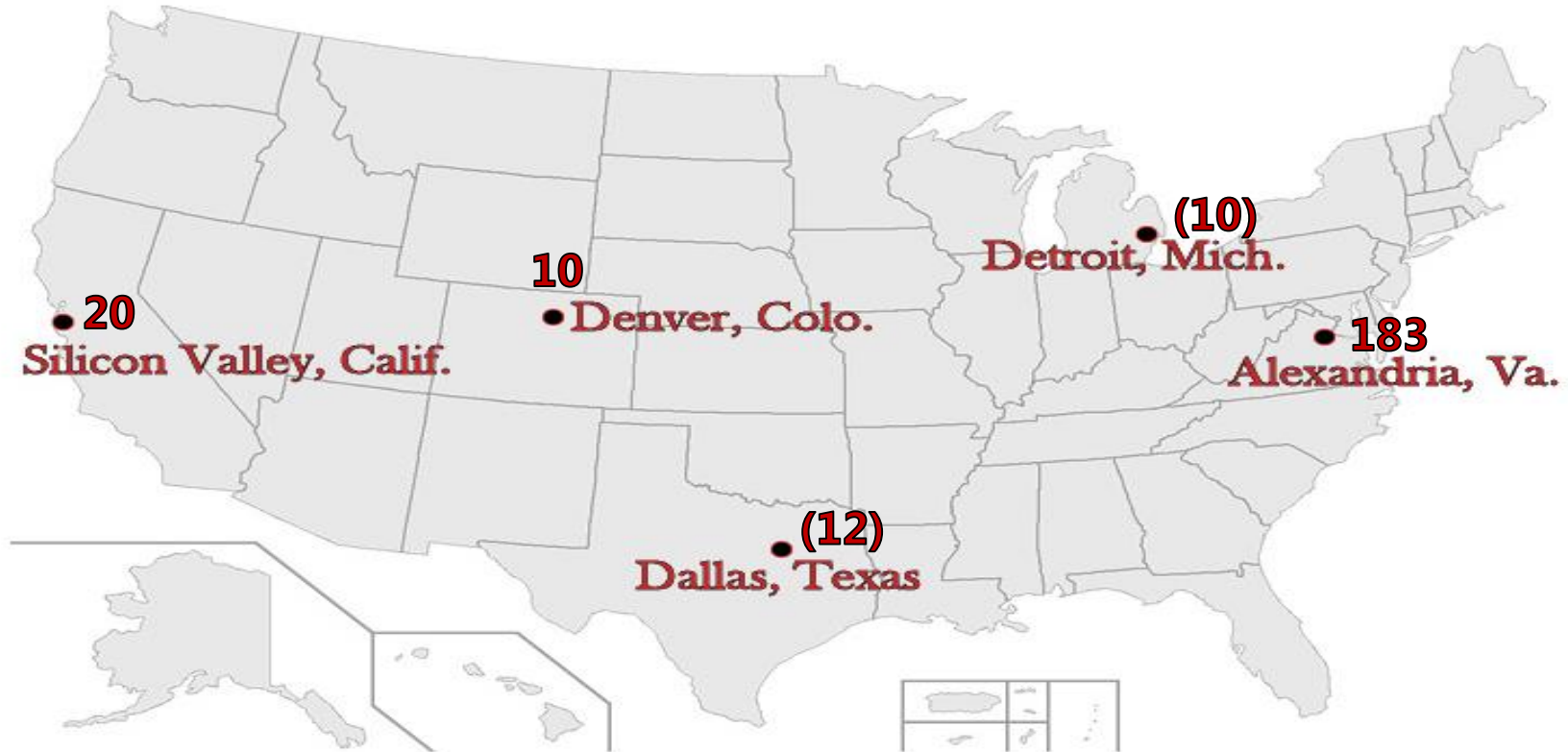


# **Administrative Patent Judge Hiring**

# Judge Members of the Board



# USPTO Locations



\*Alexandria, Va. count includes judges who participate in TEAPP.

# Questions and Comments

## **Nathan K. Kelley**

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